



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

08/786,988 01/23/97 LITTLE

D U/18485-0012

IM62/0613

EXAMINER

WARDEN, J

STEPHANIE L. SEIDMAN
HELLER EHRMAN WHITE & MCAULIFFE
4250 EXECUTIVE SQUARE, 7TH FLOOR
LA JOLLA CA 92037

ART UNIT

PAPER NUMBER

1743

27

DATE MAILED:

06/13/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.

09/786,988

Applicant(s)

Little, et al.

Examiner

Jill Warden

Group Art Unit

1743

**THE PERIOD FOR RESPONSE: [check only a) or b)]**

- a) ☐ expires _____ months from the mailing date of the final rejection.
- b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☒ Appellant's Brief is due two months from the date of the Notice of Appeal filed on May 12, 2000 (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on May 12, 2000 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

☒ The proposed amendment(s):

- ☒ will be entered upon filing of a Notice of Appeal and an Appeal Brief.
- ☐ will not be entered because:
- ☐ they raise new issues that would require further consideration and/or search. (See note below).
 - ☐ they raise the issue of new matter. (See note below).
 - ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
 - ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

☒ Applicant's response has overcome the following rejection(s):

112, second paragraph of 100 and 101 has been obviated by cancelation of these claims.

- ☐ Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.
- ☐ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
- _____
- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):
- Claims allowed: none
- Claims objected to: none
- Claims rejected: 1-6, 9-34, 40-51, and 54-99
- ☐ The proposed drawing correction filed on _____ ☐ has ☐ has not been approved by the Examiner.
- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ .
- ☒ Other See attachment


1. The declaration under 37 CFR 1.132 filed May 12, 2000 has been fully considered but is insufficient to overcome the rejection of claims 1-6, 9-34, 40-51, 54-69 and 87-101 based upon Tisone in view of Patterson as set forth in the last Office action because:

Applicants' arguments are not commensurate in scope with the claimed invention. The declaration and review article specify improved results in mass spec. analysis by forming an array from about 300 picoLiter drops, wherein 15-20 drops are dispensed into each array element, forming 4.5-6 nanoLiter volume array elements. The specific use of the picoLiter droplets provides for rapid evaporation and crystallization of the sample to be detected. The declaration and review article indicate that the mass spectrometric analysis of these arrays is improved over the prior art which teaches hundred nanoliter volume array elements. The claims in the instant application are not restricted to anything but nanoliter volume array elements, which appears to read on the prior art. Indeed, the claim restricted to volume recites 10^{-10} L to 10^{-6} L, which goes from 100 picoLiter droplets (not taught) to microLiter droplets, which are indeed taught in the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill Warden whose telephone number is (703) 308-4037. The examiner can normally be reached on Mondays-Thursdays from 7:30 am to 4:00 pm.

The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7719.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Jill Warden
Supervisory Patent Examiner
Technology Center 1700